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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/086,491	02/28/2002	Gordon S.W. Craig	003424.P029	2171
7590	11/01/2004			
Mimi Diemmy Dao BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP Seventh Floor 12400 Wilshire Boulevard Los Angeles, CA 90025-1026			EXAMINER TRINH, MINH N	
			ART UNIT 3729	PAPER NUMBER

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/086,491

**Applicant(s)**

CRAIG ET AL.

**Examiner**

Minh Trinh

**Art Unit**

3729

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 1-34 and 47-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/20/02</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Applicants traverse of the requirement for election of species in the reply filed on 8/16/04 is noted but is held to be without merits. Applicants' response is not persuasive because the reasons proffered are not relevant to an election of species. The Sections of the MPEP cited by Applicant relate to Restriction, not to the requirement for an election of species. The requirement for an election of species is found at Section 808.01(a) in the MPEP. Once claims are determined to be directed to mutually patentable inventions and the Office requires an election of species, a persuasive traverse is an admission on the record that Applicant did not demonstrate that the claimed species are individually patentable, Applicant's reasons therefore are not persuasive. Applicant is not entitled to examination of multiple independent inventions in one application. Moreover, examination of the independent inventions herein would present a serious burden to the Office in as much as the searches are not coextensive and the art is quite prolific Accordingly, the requirement is repeated and **MADE FINAL**.

2. Further, upon further review of newly submitted claims 55-65. These claims are directed to an invention other than invention of species IE, (i.e., non-elected species IB as indicted in prior Office action, paragraph 3). Thus, claims 1-34, 47-54 as well as newly claims 55-65 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 8/16/04.

An Office action on the merits of claims 35-46 as follows.

***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: "Apparatus for forming an electronic assembly" or the like.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 35-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear as to whether "a plurality of block" (claim 35, lines 5) is part of the claimed structure. Also, it is not clear as to what being claimed as "facilities even distribution of said plurality of blocks along the dispensing tube".

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 35-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohn (5,355,577).

Cohn discloses an apparatus comprising a dispensing tube or container having a plurality of orifices associated along a surface of the dispensing tube (see Fig. 3, shows a tube like having orifices on the longitudinal along a surface of the tube, and the discussion at col. 10, lines 41-42), and a vibration source (see col. 10, lines 43-44), a plurality blocks are dispensing from the orifices and the vibration source distribute the blocks along the tube or container. Thus limitation of claim 35 is met by Cohn. It is noted that the container of Cohn is as broadly readable as the claimed "dispensing tube" of the present application.

As applied to claim 36, Cohn teaches the vibration source produces frequencies with in range 2HZ-2000HZ as recited in claim 36 (see col. 5, line 35).

Limitations of claims 37-38 are also met by Cohn (see Fig. 2B or Fig. 3).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 39 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohn. Regarding limitations of claims 39 and 44. It is inherent to have provided a rotation mechanism coupling to each side of the dispensing tube in order to rotate the tube as recited in claim 39, and a transfer chamber located inside the dispensing tube as recited in claim 44. Further, since the claims directed to an apparatus and the limitation recites "and a fluid is pumped in and out of the transfer chamber " recited in claim 44 that does not further limit the claimed structure.

#### ***Allowable Subject Matter***

10. Claims 40-43 and 45-46 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

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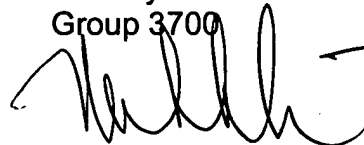
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art references cited for their teaching of apparatus for assembling and /or mounting components or the like.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Minh Trinh  
Primary Examiner  
Group 3700



10/29/04

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